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EXAMINER

SHAH, ANTIM G

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEOFFREY LANGOS, TZAHI EFRATI,
and BARUCH STERMAN

Appeal 2015-004620
Application 13/241,654
Technology Center 2600

Before JAMES R. HUGHES, JOHN D. HAMANN, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Decision rejecting claims 1–25, which constitute all the claims pending in this application. Final Act. 1–2.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ We refer to Appellants' Specification ("Spec.") filed Sept. 23, 2011 (claiming benefit of US 61/406,729 filed Oct. 26, 2010); Appeal Brief ("App. Br.") filed Sept. 5, 2014; and Reply Brief ("Reply Br.") filed Mar. 5, 2015. We also refer to the Examiner's Answer ("Ans.") mailed Jan. 5, 2015, and Final Office Action (Final Rejection) ("Final Act.") mailed Nov. 4, 2013.

Appellants' Invention

The invention at issue on appeal concerns systems and methods for recommending a first social networking system member establish a link with a second social networking system member based on matching communications activity identifiers (associated with the first and second members). Spec. ¶¶ 1–3, 83–84; Abstract.

Illustrative Claim

Independent claim 1, reproduced below with the key disputed limitations emphasized, further illustrates the invention:

1. A method implemented in an information processing apparatus having at least one processor, and for recommending that a first member of a social networking system establish a link with a second member of the social networking system, comprising:

reviewing a first member's communications activity on a telephony system to create a list of identifiers associated with the first member's communications activity;

reviewing a second member's communications activity on the telephony system to create a list of identifiers associated with the second member's communications activity;

determining, via the at least one processor, if identifiers associated with the first member's communications activity match identifiers associated with the second member's communications activity; and

recommending that a link between the first and second members be established on the social networking system if one or more of the identifiers associated with the first member's communications activity match identifiers associated with the second member's communications activity.

*References and Rejections on Appeal*²

1. The Examiner rejects claims 1–7, 9, 11–20, 22, 24, and 25 on the ground of non-statutory obviousness-type double patenting over claims 1–6, 8–17, and 19–21 (the corresponding claims) of co-pending application US 13/242,039 now US Patent No. 8,923,498 B2.

2. The Examiner rejects claims 1–25 on the ground of non-statutory obviousness-type double patenting over claims 1–19 (the corresponding claims) of co-pending application US 13/242,141 now US Patent No. 9,203,969 B2.

3. The Examiner provisionally rejects claims 1–25 on the ground of non-statutory obviousness-type double patenting over claims 1–19 (the corresponding claims) of co-pending application US 13/242,474.

4. The Examiner provisionally rejects claims 1–25 on the ground of non-statutory obviousness-type double patenting over claims 1–17 (the corresponding claims) of co-pending application US 13/241,792.

² The Examiner provisionally rejected: (1) claims 1–7, 9, 11–20, 22, 24, and 25 over claims 1–6, 8–17, and 19–21 of co-pending application US 13/242,039 (“’039 App.”); (2) claims 1–25 over claims 1–13 of co-pending application US 13/242,196 (“’196 App.”); (3) claims 1–25 over claims 1–17 of co-pending application US 13/242,474 (“’474 App.”); (4) claims 1–25 over claims 1–17 of co-pending application US 13/241,792 (“’792 App.”); and (5) claims 1–25 over claims 1–19 of co-pending application US 13/242,141 (“’141 App.”). Final Act. 2–5. Application US 13/242,039 has issued as US Patent No. 8,923,498 B2. Application US 13/242,141 has issued as US Patent No. 9,203,969 B2. Application US 13/242,196 has been abandoned — we do not address this ground of rejection and in the event of further prosecution suggest the Examiner withdraw the rejection as moot. We update the Examiner’s grounds of rejection for clarity and consistency of the record.

5. The Examiner rejects claims 1–6 and 13–19 under 35 U.S.C. § 102(b) as being anticipated by O’Donoghue et al. (US 2009/0163183 A1; published June 25, 2009) (“O’Donoghue”).

6. The Examiner rejects claims 7–12 and 20–25 under 35 U.S.C. § 103(a) as being unpatentable over O’Donoghue and Shen et al. (US 2010/0057858 A1; published Mar. 4, 2010) (“Shen”).

RELATED APPEALS

Appellants indicate that a Notice of Appeal was filed for a related patent application, U.S. Patent Application No. 13/242,196, on July 28, 2014. App. Br. 3. The Examiner reopened prosecution (*see* Notice of Panel Decision from Pre-Appeal Brief Review mailed February 18, 2015) and the application subsequently was abandoned (*see* Notice of Abandonment mailed November 18, 2016). We note that related patent application, U.S. Patent Application No. 13/241,792 is also the subject of an Appeal to the Board. The appeal has been assigned Appeal No. 2015-007415. The Board has not issued a decision on Appeal No. 2015-007415. We further note that related patent application, U.S. Patent Application No. 13/242,474 is also the subject of an Appeal to the Board. The appeal has not yet been assigned an Appeal Number and the Board has not issued a decision with respect to this appeal.

ISSUE

Based upon our review of the administrative record, Appellants’ contentions, and the Examiner’s findings and conclusions, the pivotal issue before us follows:

Does the Examiner err in concluding that O'Donoghue discloses "recommending that a link between the first and second members be established on the social networking system if one or more of the identifiers associated with the first member's communications activity match identifiers associated with the second member's communications activity," within the meaning of Appellants' claim 1 and the commensurate limitations of claims 13 and 14?

ANALYSIS

The Double Patenting Rejections

Appellants do not address the Examiner's double patenting rejections or the Examiner's findings with respect to US Patent No. 8,923,498 B2 (the '039 App.); US Patent No. 9,203,969 B2 (the '141 App.); co-pending application US 13/242,474; and/or co-pending application US 13/241,792 —

Claims 1–25 were rejected under four separate provisional double patenting rejections in view of four corresponding co-pending applications. However, because all of these rejections are provisional rejections, Appellants request that they be held in abeyance until the other issues in this Appeal have been decided, and until such time as one of the other co-pending applications matures into a patent.

App. Br. 9. Accordingly, we summarily affirm the Examiner's non-statutory obviousness-type double patenting rejections of claims 1–25.

The § 102 Rejection

The Examiner rejects independent claims 1–6 and 13–19 as being anticipated by O'Donoghue. *See* Final Act. 5–8; Ans. 2–7. Appellants contend that O'Donoghue does not disclose the disputed features of claim 1.

App. Br. 9–14; Reply Br. 1–5. Specifically, Appellants contend “that O’Donoghue is not even related to ‘social networking systems’” (App. Br. 10) and “fails to disclose . . . generating any recommendations that two members of a social networking system form a link on the social networking system,” but instead “generates . . . recommendations to purchase goods and services” based on “what goods and services the members of an individual’s local network have recently purchased” (App. Br. 11). In short, “O’Donoghue fails to disclose or suggest generating any sort of recommendation that a link be formed between first and second members of a social networking system, as recited in claim 1.” App. Br. 11.

We agree with Appellants O’Donoghue does not disclose the recited recommendation generation (of a link between members of a social networking system). *See* App. Br. 9–11; Reply Br. 1–5. Indeed, the Examiner fails to sufficiently map or explain what features of O’Donoghue the recited recommendation generation reads on. *See* Final Act. 6; Ans. 2–4.

Consequently, we are constrained by the record before us to find that the Examiner erred in finding that O’Donoghue discloses the disputed limitations of Appellants’ claim 1. Independent claims 13 and 14 include limitations of commensurate scope. Dependent claims 2–6 and 15–19 depend on claims 1 and 14, respectively. Accordingly, we reverse the Examiner’s anticipation rejection of claims 1–6 and 13–19.

The § 103 Rejection

With respect to dependent claims 7–12 and 20–25 rejected as obvious over O’Donoghue and Shen, we reverse the Examiner’s obviousness rejection for the same reasons set forth with respect to claim 1 (*supra*). The

Examiner does not suggest, and we do not find that the addition of Shen cures the deficiencies of O'Donoghue (discussed *supra*).

CONCLUSIONS

Appellants have not shown that the Examiner erred in rejecting claims 1–25 on the grounds of non-statutory obviousness-type double patenting. Appellants have shown that the Examiner erred in rejecting claims 1–6 and 13–19 under 35 U.S.C. § 102(b) and claims 7–12 and 20–25 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejections of claims 1–25.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED